

REMARKS

Claims 1 and 8 have been amended. No claims have been added or canceled. Hence claims 1 – 10 and 19 – 44 are pending in the Application.

Claims 1 – 10 and 19 – 28 are allowed.

Claims 29 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,778,642, herein Schmidt.

CLAIM 29

Claim 29 contains numerous features not disclosed or suggested by the cited art. For example, Schmidt fails to disclose or suggest in anyway "generating a first identifier that is unique relative to other identifiers assigned to the messages by the first client [of a first mailbox] and a second client of the second mailbox."

The Office Action alleges that Schmidt teaches this limitation. However, the Office Action has completely failed to make an adequate showing of what in Schmidt discloses the above feature. Furthermore, nothing in the Schmidt expressly or implicitly describes the limitation, as required for 102(e).

I. The Office Action constructively admits Schmidt fails to anticipate claim 29 by failing to specifically identify elements in Schmidt that correspond to generating a first identifier that is unique relative to other identifiers, as claimed.

To support the allegation that the Schmidt teaches the limitation of "generating a first identifier that is unique relative to other identifiers assigned to the messages by the first client [of a first mailbox] and a second client of the second mailbox," the Office Action cites a large excerpt of Schmidt (i.e. col. 5 line 37 to col. 7, line 27, and abstract). However, the Office Action fails to specify any specific item or action in the cited excerpt that correlates to this limitation. Furthermore, Applicant has thoroughly examined

the cited excerpts and has not found any teaching generating a first identifier that is unique relative to other identifiers assigned to other messages, as claimed.

In an Office Action “the particular part relied on must be designated as nearly as practicable ... The pertinence of each reference, if not apparent, must be clearly explained ...” (37 C.F.R. § 1.104; MPEP 707). As shown above, the pertinence of the excerpts are not apparent and are not clearly explained. Instead, large portions of the reference are simply identified in a non-specific way. The failure to specify any item or action in the excerpts that correlates to "generating a first identifier that is unique relative to other identifiers assigned to the messages by the first client [of a first mailbox] and a second client of the second mailbox", is tantamount to admitting that Schmidt fails to describe what the Office Action alleges Schmidt to describe.

II. The Office Action has failed to show that Schmidt qualifies as prior art for 102(e).

The present application is a continuation of U.S. Patent No. 6,360,272, which was filed on May 28, 1999. Therefore, the effective filing date of the present application is May 28, 1999.

The filing date of Schmidt is Feb. 22, 2000, which is after the effective filing date of the present application. Apparently the Office Action is relying on U.S. Provisional application No. 60/127,746, filed on March 23, 1999, to which Schmidt ostensibly claims priority, as making March 23, 1999 the effective filing date of Schmidt and qualifying Schmidt as prior art.

MPEP 706.02(f)(1)(I) states:

I. DETERMINE THE APPROPRIATE 35 U.S.C.102(e)>DATE<FOR EACH POTENTIAL REFERENCE BY FOLLOWING THE GUIDELINES, EXAMPLES, AND FLOW CHARTS SET FORTH BELOW:

...

The 35 U.S.C. 102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C.119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection **>in compliance with 35 U.S.C.112,first paragraph. See MPEP §2136.02<.

The Office Action only cites portions of Schmidt, but does not cite portions of Schmidt's parent provisional application. The Office Action therefore fails to even attempt to show that the prior parent provisional supports the subject matter relied upon to reject claim 29. Accordingly, Schmidt cannot be used as prior art.

III Schmidt fails to teach each and every element of claim of 29 and thus fails to anticipate claim 29.

To anticipate a claim, the reference must teach every element of the claim. MPEP 2131 states a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Id., Verdegaal Bros.v.Union Oil Co.of California, 814 F.2d 628,631,2 USPQ2d 1051,1053

MPEP 706.02(IV) states that for "anticipation under 35 U.S.C.102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present."

MPEP 2112(IV) states: "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

Schmidt discloses assigning identifiers to messages. The identifiers uniquely identify types of messages. Schmidt, for example, describes a "new message identifier" (col. 6, line 50), a "voice mail identifier" (col. 6, line 61), and an "E-mail type identifier" (col. 6, line 66). Thus, while Schmidt expressly teaches that identifiers identify a type of

message, at best, Schmidt expressly describes an type identifier assigned to messages that is unique relative to other message types, but Schmidt does not expressly describe an "identifier that is unique relative to other identifiers assigned to...messages", as claimed.

Furthermore, it does not necessarily flow from Schmidt that identifiers for types of messages are unique relative to identifiers assigned to other messages. In fact, the opposite necessarily flows. The identifiers are intended to be the same as identifiers assigned to other messages, so that the messages associated with the same identifier are grouped as belonging to the particular type associated with the identifier. For example, FIG. 5 shows multiple messages as a Voice message, multiple messages as a FAX message, and multiple messages as a E-mail message. FIG. 5 demonstrates that multiple messages are assigned the same identifier for a Voice message, multiple messages are assigned the same identifier for a FAX message, and multiple messages are assigned the same identifier for an E-mail message.

Schmidt thus fails to expressly and inherently teach "generating a first identifier that is unique relative to other identifiers assigned to the messages by the first client [of a first mailbox] and a second client of the second mailbox." Therefore, Schmidt fails to either expressly or inherently describe all the elements of claim 29 and claim 29 is patentable.

Remaining Pending Claims

The pending claims not discussed so far are dependant claims that depend on an independent claim that is discussed above. Because each of the dependant claims include the limitations of claims upon which they depend, the dependant claims are patentable for at least those reasons the claims upon which the dependant claims depend are patentable. Removal of the rejections with respect to the dependant claims and allowance of the

dependant claims is respectfully requested. In addition, the dependent claims introduce additional limitations that independently render them patentable. Due to the fundamental difference already identified, a separate discussion of those limitations is not included at this time.

For the reasons set forth above, Applicant respectfully submits that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Respectfully submitted,

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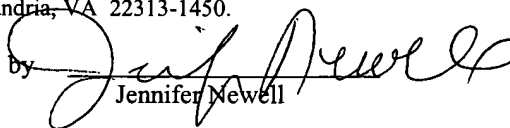
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on May 25, 2005

by



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